

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

MMB Docket No. **1781-0015**

Urquhart Reference: **SJB/P011701US**

Confirmation No. **8850**

Application of: **Lane et al.**

Group Art Unit: **1797**

Serial No. **10/521,884**

Examiner: **Amber Rose Orlando**

Filed: **October 20, 2005**

For: **Coalescing Filter Element**

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REPLY BRIEF

Mail Stop Appeal Brief – Patents
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Sir:

The Examiner's Answer mailed December 10, 2008 contains a lengthy discussion of how three different devices disclosed in prior art references (namely, Guenter, Billiet, and Gieseke) can be cannibalized and then further modified to attain Appellants' claimed

invention. (See Examiner's Answer at page 8, line 8 through page 12, line 5.) However, what is conspicuously lacking from the Examiner's discussion is an articulation of an adequate rationale for combining and modifying these prior art references in this particular manner.

Further, the proposed combination/modification set forth in the Examiner's Answer (see, e.g., page 8, lines 9-17) is a relatively complex one. Indeed, it appears the Examiner proposes taking the end cap structure 1 of the Guenter's filter device and removing it and then modifying it so that it includes part of Billiet's end cap 63 (i.e. its edges – shown in Fig. 7, object 63), which in turn is further modified to have peripheral openings bordering the edges of this initially modified end cap. Further, the proposed combination/modification then involves taking this newly created end cap and placing it near Billiet's filter (which was itself modified to have its end cap 63 removed) so that the inlet of the newly designed end cap is floating in space in the middle of the inlet of the modified Billiet filter, and then further taking the vanes 150 of Gieseke's device, and securing them between the inner tube (i.e. item 6) of the newly designed end cap and the filter walls (i.e. Billiet's walls 60) so as to hold in place the otherwise floating newly created end cap. One skilled in the art would not pursue such a complex undertaking absent a compelling reason to do so. No such compelling reason exists.

The Examiner's Answer does attempt to identify a reason as why a skilled artisan may want a peripheral opening in this newly created end cap, (see Examiner's Answer at page 4, lines 7-11 - to provide an air way for which the gas can flow through it). However, as discussed in the Appellants' Appeal Brief, the end cap of the combined/modified Guenter/Billiet device would already have an air way for gas to flow

to the hollow space defined by the wall element. Indeed, according to the proposed combination/modification of Guenter and Billiet, the newly created end cap would include the large opening of Billiet's end cap. (See, e.g., Examiner's Answer at page 9, last three lines.) Thus, no rational reason exists as to why a skilled artisan would want to further modify the end cap to create a peripheral opening therein, much less, as to why a skilled artisan would combine/modify Guenter, Billiet, and Gieseke in the highly complex manner as proposed by the Examiner.

Accordingly, one skilled in the art would *not* have found it reasonable to combine/modify Guenter, Billiet, and Gieseke in the manner proposed in the Examiner's Answer. Thus, a prima facie case of obviousness under 35 U.S.C. § 103 has not been established with regard to claim 1. Each of claims 2-9 directly or indirectly include the limitations of claim 1. Consequently, claims 1-9 are allowable, and the Board of Appeals is requested to reverse the rejection of claim 1-9.

Please charge any and all government fees required for the filing of this Reply Brief to Deposit Account No. 13-0014. Also, please provide any extensions of time that may be necessary and charge any fees that may be due to Deposit Account No. 13-0014, but not to include any payment of issue fees.

Respectfully submitted,

February 10, 2009

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